

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Breitenbach, A., *et al.*
Serial No.: 10/523,908
Filed: January 28, 2005
Title: HOT MELT TTS FOR ADMINISTERING ROTIGOTINE
Group Art Unit: 1618
Examiner: H.S. Ahmed
Confirmation No.: 9463
Docket No.: 6102-000075/US/NP
Client Ref.: P/Br/I/5/02

SUBMITTED ELECTRONICALLY VIA EFS-WEB

March 18, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO OFFICE ACTION DATED FEBRUARY 7, 2008

(INCLUDING PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. §1.136(a))

This paper is responsive to the Office Action dated February 7, 2008 in the above referenced application, in which a shortened statutory period of one month was set. Applicant hereby makes petition for extension of time of one (1) month to respond to the present Action. Authorization is provided herewith to charge the fee required under §1.17(a)(1) to Deposit Account No. 08-0750.

By the present Action, Applicant is required under 35 U.S.C. §§121 and 372 to restrict the application to one of the following groups:

- I Claims 28 (part), 29–37 and 42–44, drawn to a TTS (transdermal therapeutic system) comprising a drug-containing adhesive matrix that contains a hot-meltable adhesive;
- II Claims 28 (part) and 38–41, drawn to a TTS comprising a drug-containing adhesive matrix that contains a hot-meltable adhesive and an internal-phase

component;

- III Claims 45–51, drawn to a TTS comprising a drug-containing layer; and
- IV Claims 52–59, drawn to a method for making a TTS comprising a drug-containing adhesive matrix that contains a hot-meltable adhesive.

Applicant elects Group I (Claims 28 (part), 29–37 and 42–44), with traverse. The restriction requirement is traversed on the ground that, although patentably distinct from one another, Groups I and II relate to a single general inventive concept wherein rotigotine or a prodrug thereof is contained in an adhesive matrix that contains a hot-meltable adhesive. It is noted that Claim 28 is generic to Groups I and II. The requirement of Claims 38–41 (Group II) that the matrix further comprise an additional element, namely an internal-phase component, although resulting in a patentably distinct subgenus, does not create an additional search burden for the Examiner.

Applicant is further required to elect a species, to which the claims shall be restricted if no generic claim is finally held to be allowable. By election of a species herein, no admission is made or should be inferred that Applicant considers the invention to be limited to that species. This election is made without traverse.

The drug species provisionally elected by Applicant is that embodied in Claim 42, wherein the drug is rotigotine.

At least the following claims of Groups I and II are readable on the provisionally elected species: Claims 28–42.

No amendment of inventorship is believed necessary as a result of election herein.

Applicant respectfully points out the following error in the present Action. At page 2, the Action characterizes Group III (Claims 45–51) as drawn to a TTS comprising a layer “not including an adhesive matrix.” While it is true that Claims 45–51 do not expressly recite an adhesive matrix, they do not exclude presence of an adhesive matrix.

Applicant believes the application is now in condition for examination on the merits. Should any issues remain, the Examiner is invited to call the undersigned at the telephone number given below.

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Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

James C. Forbes

James C. Forbes

Agent for Applicant

Reg. No. 39,457

Tel. 847-412-6350